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Technology Center 2100

In re Application of: WILKINSON, et al.
Application No. 10/676,637
Filed: 1 October 2003
For: DETERRING NETWORK INCURSION

DECISION ON PETITION
TO MAKE SPECIAL
(ACCELERATED EXAMINATION)
UNDER M.P.E.P. §708.02 (VIII)

This is a decision on Applicant's petition filed 23 January 2006, under 37 C.F.R. 102(d) and M.P.E.P. § 708.02(VIII): Accelerated Examination.

The Petition is **DISMISSED**.

M.P.E.P. § 708.02, Section VIII which sets out the prerequisites for a grantable petition for Accelerated Examination under 37 C.F.R. § 102(d) states in relevant part:

A new application (one which has not received any examination by the examiner) may be granted special status provided that applicant (and this term includes applicant's attorney or agent) complies with each of the following items:

- (a) Submits a petition to make special accompanied by the fee set forth in 37 CFR 1.17(h);
- (b) Presents all claims directed to a single invention, or if the Office determines that all the claims presented are not obviously directed to a single invention, will make an election without traverse as a prerequisite to the grant of special status;
- (c) Submits a statement(s) that a pre-examination search was made, listing the field of search by class and subclass, publication, Chemical Abstracts, foreign patents, etc. The pre-examination search must be directed to the invention as claimed in the application for which special status is requested. A search made by a foreign patent office satisfies this requirement;
- (d) Submits one copy each of the references deemed most closely related to the subject matter encompassed by the claims if said references are not already of record; and
- (e) Submits a detailed discussion of the references, which discussion points out, with the particularity required by 37 CFR 1.111 (b) and (c), how the claimed subject matter is patentable over the references.

In this case, the petition fails to adequately meet the requirements (b) and (e) as set forth supra. With respect to requirement (b), Petitioner should state the instant application “presents all claims directed to a single invention”. Responsive to requirement (e), applicant must provide a “detailed discussion of the references, which discussion points out, with the particularity required by 37 CFR 1.111 (b) and (c), how the claimed subject matter is patentable over the references.” Petitioner should ensure that the above discussion is directed to *how the language of each of the independent claims are specifically distinguishable and patentable from the relevant prior art references*.

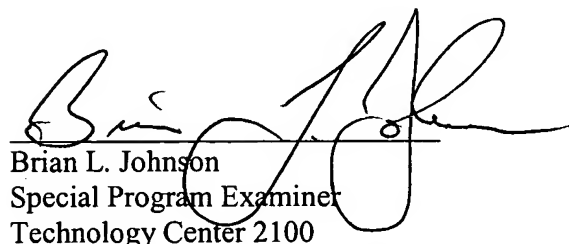
The petition filed 23 January 2006 fails to properly discuss **claimed limitations** with respect to the references in accordance with the requirements of 37 CFR 1.111 (b) and (c). In the discussion of the references, Petitioner alludes to some claim features to distinguish each of the independent claims from the prior art in the identified references. For example, in dealing with the Connary reference, the petition asserts that “determining a response . . . requires more information than is available from examining that given packet and determining whether the source address is a threat” which makes “claims 1, 42, 57 and 72” distinguishable over the reference, however, this recitation in fact is not what the claim states nor congruous with it. The detailed discussion must show, for each independent-claim, actual limitations/language from each independent claim that distinguish over each given reference in order to specify “how the claimed subject matter is patentable over the references.”

To “make special” an Application under MPEP § 708.02(VIII), a petition is required to provide a **detailed discussion that includes identifying claim limitations with particularity for each independent-claim** that shows how the claimed invention distinguishes over the relevant teachings of each reference. Specific claim language/limitations cannot be substituted or paraphrased as such may misrepresent the case. The detailed discussion must recite and use the precise claim language/limitations to adequately and validly compare Applicant’s invention with the prior art references.

Petition to Make Special **DISMISSED**.

Petitioner is given one opportunity to perfect the petition. Any request for reconsideration must be filed within TWO MONTHS of the mail date of this decision.

Until the renewed petition is submitted, the application will be returned to the examiner’s docket to await treatment on the merits in the normal order of examination.



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